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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,177	12/03/2003	Mary C. Tannenbaum	005708/P010US/08008819	5985

29053 7590 11/28/2006

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,177	TANNENBAUM, MARY C.	
	Examiner	Art Unit	
	Gerald Gauthier	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36,44 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 19-27 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7,8,10-13,15--18,28,30-34,36,44,48 and 51 is/are rejected.
- 7) ☐ Claim(s) 4,6,9,14,29,35,49 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. **Claim(s) 1-18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the previously stored play time" in line6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claim(s) 1-3, 5, 7, 8, 10-13, 15-18, 28, 30-34, 36, 44, 48 and 51** are rejected under 35 U.S.C. 102(e) as being anticipated by Brue (US 2006/0139150 A1).

Regarding **claim(s) 1**, Brue discloses a system for recording messages (paragraph 0002), said system comprising:

a memory (122 on FIG. 7) for storing at the recipient's location a time to play a particular message at said system, said play time being later than the time said communication is received at said system (paragraph 0043); and

a device (132 on FIG. 7) for playing said particular message at the previously stored playtime associated with said particular message (paragraph 0082).

Regarding **claim(s) 2 and 34**, Brue discloses a system, wherein said messages are played at said play time without regard to any action taken by said message recipient (paragraph 0082).

Regarding **claim(s) 3**, Brue discloses a system, wherein said messages are audio messages played by a speaker (paragraph 0082).

Regarding **claim(s) 5**, Brue discloses a system, wherein at least a portion of said particular message is received concurrently with said play time for storage in said memory over a communication path extending from a location remote from said recipient's location (paragraph 0082).

Regarding **claim(s) 7**, Brue discloses a system, wherein said playtime is a plurality of different times (paragraph 0082).

Regarding **claim(s) 8, 33 and 48**, Brue discloses a system, wherein said memory is further operable for receiving messages that do not have controlled play times associated therewith and wherein said system further comprises: a processor operable in response to instructions received with a message play time for controlling the play of at least one of said messages not having controlled play times associated therewith (paragraph 0043).

Regarding **claim(s) 10**, Brue discloses a system, wherein the selection of said last mentioned message is controlled, at least in part by information received from a message sender (paragraph 0082).

Regarding **claim(s) 11 and 31**, Brue discloses a system, wherein the selection of said last-mentioned message is controlled, at least in part, by local sensors (paragraph 0082).

Regarding **claim(s) 12 and 30**, Brue discloses a system, wherein said sensors are selected from the list of thermometer, clock, GPS, calendar, physiological (paragraph 0082).

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Regarding **claim(s) 13**, Brue discloses a system, wherein a played one of said messages is played continuously for a period of time as controlled by information received with the message (paragraph 0082).

Regarding **claim(s) 15**, Brue discloses a system, further comprising an override control for playing selected ones of said messages at a time established independent of said play time associated with said selected ones of said messages (paragraph 0082).

Regarding **claim(s) 16 and 51**, Brue discloses a system, wherein said device, at a playtime, enables downloading of pre-identified messages stored at a location remote from said recipient location (paragraph 0082).

Regarding **claim(s) 17 and 32**, Brue discloses a system, further comprising: means for converting any received message to a particular format, said particular format controlled by said recipient's system (paragraph 0082).

Regarding **claim(s) 18 and 36**, Brue discloses a system, wherein said controlled playtime is a message recipient specific time category, instead of a specific time (paragraph 0082).

Regarding **claim(s) 28**, Brue discloses a messaging system paragraph 0002) comprising:

a processor (120 on FIG. 7) co-located with a potential message recipient for controlling receipt of incoming messages to said recipient (paragraph 0043);

said processor operable for controlling interaction with a message sender such that attributes established by said sender can be associated with at least some received messages, said processor further operable for controlling playback of said message to said recipient at said co-location in accordance with said attributes and wherein at least one of said attributes is a time of said playback (paragraph 0082);

said playback occurring without any action being required of said recipient (paragraph 0082).

Regarding **claim(s) 44**, Brue discloses a method for delivering messages to a recipient (paragraph 0002), said method comprising:

creating a message to be sent to a recipient (paragraph 0082);

each said created message having associated therewith a time to deliver said message to said recipient (paragraph 0043);

storing each said created message in association with said message delivery time at a device local to said recipient (paragraph 0043); and

playing each said stored message under control of said local device for said recipient (paragraph 0043); and

without any action being required of said recipient at said time associated with said stored message without action taken by said recipient at the time each said message is played, said playing occurring without a communication being established to said local device from a source external to said local device at said time each message is played (paragraph 0082).

Allowable Subject Matter

5. **Claim(s) 19-27** are allowed.
6. **Claim(s) 4, 6, 9, 14, 29, 35, 49 and 50** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments


7. Applicant's arguments with respect to **claim(s) 1-36, 44 and 48-51** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gerald Gauthier
Primary Examiner
Art Unit 2614

GG
November 27, 2006